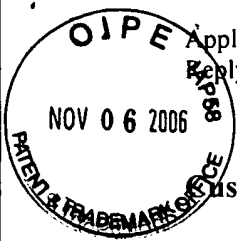


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Application Number 09/965,163
Reply Brief filed on November 6, 2006

Customer No. 30223

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application. No. : 09/965,163
Appellant : Shridhar P. Joshi
Filed : September 27, 2001

Title : Gaming Machine With Sweepstakes Entry Dispenser

TC/A.U. : 3714
Examiner : Alex P. Rada

Docket No. : 47079-00117USPT

REPLY BRIEF
PURSUANT TO 37 C.F.R. 41.41(a)(1)

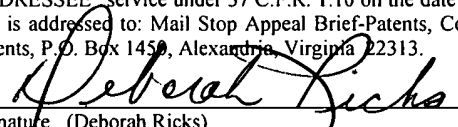
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Signature (Deborah Ricks)

Dear Commissioner:

This Reply Brief is being filed pursuant to 37 C.F.R. § 41.41(a)(1) and within two months of the Examiner's Answer, *i.e.*, by November 6, 2006.

A. STATUS OF CLAIMS

Claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37 and 38 have been finally rejected. Claims 2, 5-13, 15, 17, 19, and 22-26 have been cancelled. Claims 28-36, and 39 have been withdrawn. It is from the final rejection of claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37 and 38 that this appeal is taken.

B. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Whether claims 1, 3, 4, 14, 16, 18, 20, 21, 27, 37, and 38 were properly rejected under 35 U.S.C. § 103(a) based on a combination of references that includes U.S. Patent No. 5,851,148 (“Brune”), where claims 1, 14, 18, and 27 were rejected over U.S. Patent Publication No. 2002/0093136 (“Moody”) in view of Brune and U.S. Patent Publication No. 2003/0036427 (“Brandstetter”) and claims 37 and 38 were rejected over Moody in view of Brune, Brandstetter, and U.S. Patent Publication No. 2001/0039513 (“Erlichson”).

II. Whether claim 38 was properly rejected under 35 U.S.C. § 103(a) based on a combination of references that includes Erlichson, where claims 37 and 38 were rejected over Moody in view of Brune, Brandstetter, and Erlichson.

C. ARGUMENT

In addition to the arguments presented in the Appellant's Appeal Brief of June 15, 2006, the Appellant presents the following arguments in reply to the Examiner's Answer of September 6, 2006. The Examiner's Answer fails to support the allegations I) that "the suggestion to combine" Brune with Moody "is found within the teachings of the combined references," and II) that Erlichson discloses a security access code for allowing access to the website.

I. The Alleged Suggestion To Combine Brune with Moody Is Not Found Within The References Themselves Or Within The General Knowledge Of A Skilled Artisan

The Examiner's Answer fails to identify any suggestion or motivation to combine Brune with Moody. Evidence of a suggestion, teaching, or motivation to combine "must be clear and particular." *Ex parte Maruyama*, 2001 WL 1918556, *3 (Bd. Pat. App. & Inter. 2001), (citing *C.R. Bard, Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)) (emphasis added).

At most, the arguments are allegations that the references teach one or more claim elements. However, "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)) (emphasis added).

The Examiner's Answer alleges that one of ordinary skill in the art would combine Moody with Brune to "provide game players with unexpected results like an increase in payout or other bonus type events." First, it is unclear what the motivation of "unexpected results" has to do with combining Moody and Brune in view of the missing claim element that is lacking in

Moody. Second, there is no citation provided regarding a motivation of “unexpected results” in Moody and Brune (which he alleged that “is found within the teachings of the combined references”).

First, the motivation of “unexpected results” has nothing to do with combining Moody and Brune in view of the missing claim element from Moody. The Examiner’s Answer uses an analysis in which Moody is modified to “include a plurality of different triggering events,” which are allegedly taught by Brune. There is no connection between the “triggering events” missing in Moody and the “unexpected results” motivation. To properly combine Moody and Brune, it must be clearly shown that a problem presented by Moody is solved by a solution provided by Brune.

In our case, the alleged problem presented by Moody seems to be that it lacks a teaching related to “a predetermined triggering condition.” Brune is used to provide the missing claim element. However, there is no connection between the missing “predetermined triggering condition” teaching in Moody and the “unexpected results” motivation. In other words, a person of ordinary skill in the art would not be motivated to combine Moody and Brune even if a motivation of “unexpected results” was presented by either Moody or Brune because there is no connection between “a predetermined triggering condition” and the “unexpected results” motivation.

Second, even if there is some connection between the alleged “unexpected results” motivation (which there is not) and the missing “predetermined triggering condition” in Moody, nowhere does Moody (or Brune) disclose such motivation. Initially, it is noted that there is no clear identification as to where the motivation is disclosed in Moody or Brune. This fails to

satisfy the clear evidence requirement, as stated by the Board in *Ex parte Maruyama*, and contradicts the Examiner's allegation that the motivation "is found within the teachings of the combined references." 2001 WL 1918556, *3 (Bd. Pat. App. & Inter. 2001).

Additionally, a review of Moody and Brune fails to identify that an objective of either reference was to provide unexpected results for the player, *e.g.*, to surprise the player with an unexpected award. For example, Moody is directed generally to having gaming machines "interact with the world wide web on a real time basis" and, more specifically, to "utilize the electronic gaming machine to dispense awards to the player in the form of a keno ticket, a lottery ticket, a sweepstakes ticket, an entry into a prize context, a redeemable coupon or other valuable printed award." Moody, ¶¶ 14 and 16. There is no mention in Moody regarding using predetermined triggering conditions for dispensing a sweepstakes ticket. Similarly, there is no mention in Brune regarding using a "predetermined triggering condition" in a dispensing machine such as the one disclosed by Moody. Brune is directed to "an incentive for multi-game or multi-hand play by establishing one or more goals, preferably associated with a prize, such that multiple games or hands are required to reach the goals." Brune, column 1, lines 34-37. Thus, the unrelated motivation of "unexpected results" is not disclosed within the cited references.

It is apparent that the motivation to combine Moody and Brune has been taken from the Appellant's own specification. This is clearly improper, because obviousness cannot "be established using hindsight or in view of the teachings or suggestions of the invention." *Ex parte Maguire* (Appendix 9), 2002 WL 1801466, *3 (Bd. Pat. App. & Inter. 2002), (*quoting Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239

(Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)). In other words, the knowledge to combine “*can not* come from the applicant’s invention itself.” *Oetiker*, 977 F.2d at 1447, 24 U.S.P.Q.2d at 1446, emphasis added.

II. Erlichson Fails To Disclose A Security Access Code For Allowing Access To The Website

The Examiner’s Answer fails to identify anywhere in Erlichson a disclosure regarding having a “security access code.” The Examiner’s Answer alleges that “Erlichson et al in figure 4 teaches the website having a security access code for allowing access to the website,” and that “logging into the sweepstakes repository on the Internet is the security access code for allowing access to the website.” Seemingly, it is assumed that the disclosed “logging” process necessarily includes using a “security access code.” This assumption is unsupported by Erlichson.

Nowhere does Erlichson disclose (and the Examiner’s Answer does not allege that Erlichson discloses) that the “logging” process requires a security access code, *e.g.*, a password. It is entirely possible that the “logging” process only requires the user to simply click on a specific item, to simply open a particular web browser, to navigate through a specific menu of options, etc. In fact, a text search of Erlichson failed to identify any words that may be related to a security access code, *e.g.*, “secret,” “access,” “prevent,” “private,” etc.

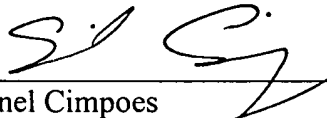
Thus, Erlichson fails to disclose the claim element directed to a “security access code.”

III. Conclusion

For the reasons set forth above and the reasons set forth in the Appellant’s Appeal Brief of June 15, 2006, all of the appealed claims are deemed allowable over the cited references. Applicant respectfully requests that the rejection of the appealed claims be reversed, and that this application be returned to the Examiner with directions to issue a Notice of Allowance.

It is the Applicant's belief that no fees are due at this time. However, the Commissioner is authorized to charge any additional fees inadvertently omitted that may be required (except the issue fee) now or during the pendency of this application to JENKENS & GILCHRIST, P.C. Deposit Account No. 10-0447(47079-00117USPT).

Date: November 6, 2006



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